

REMARKS

Applicant acknowledges that the finality of the previous Office Action has been withdrawn and that Applicant's submission filed on October 31, 2007 has been entered, pursuant to a Request for Continued Examination. Applicant would like to thank the Examiner for the courtesies extended during the telephone conference of May 14, 2008. Generally, the art of record was discussed. No agreement as to patentability of the claims was reached.

Claims 1-3, 5-11, 13-15, 17, 19-22, 24, 26, and 27 are now pending in the application. Claims 1-3, 5-11, 13-15, 17, 19-22, 24, 26, and 27 stand rejected, and Claims 1, 13, 19, 26, and 27 have been amended. Support for the amendments can be found in paragraph [0020] of the application drawings and claims as originally filed and, as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

SPECIFICATION

Item 9 of the Office Action Summary indicates that the specification is objected to by the Examiner; however, there is nothing in the body of the Office Action that speaks to any objection to the specification. Applicant respectfully requests clarification in this regard.

CLAIM OBJECTIONS

Claims 26 and 27 stand objected to for certain informalities, specifically regarding “the pair of planar surfaces” and “the flange surface.” Applicant has amended these claims according to the Examiner’s suggestions. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

Claims 19-22, 24 and 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claims 19 and 27, thus obviating the rejection.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-3, 5, 7-11, 13, 14, 17, 19-22, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sutter et al. (U.S. Pat. No. 4,328,593). In view of the arguments and amendments herein, this rejection is respectfully traversed.

The Examiner’s attention is directed to Claim 1 which has been amended to include the clarifying limitation that the extended articulating surface extends from only a portion of the terminating rim of the hemispherical exterior articulating surface. Applicant notes the Sutter reference does not teach this limitation.

Claims 13 and 19 have been amended to include the limitation that the hemispherical articulating surface terminates generally at a hemispherical equator. These claims further have been amended to include the limitation that the flange

extended surface, and extending articulating surface, protrude only from a portion of the hemispherical equator. Applicant submits the Sutter reference does not teach this limitation.

With respect to the rejection of the method claims, the Office cites column 6, lines 12-15, for teaching “to form a pair of intersecting planar surfaces.” Applicant directs the Examiner’s attention to column 6, lines 15-21, of the Sutter reference which states, “ribs 3g must therefore be pressed into the bone material when prosthesis 1 is attached in femur pivot 11d in the direction of rotational symmetry axis 5.” Applicant submits the Sutter reference does not teach “resecting a portion of the humeral head so as to form a pair of intersecting flat planar surfaces” as is claimed. Applicant submits that contrary to the assertion of the Office, the formation of these intersecting surfaces using resection allows the treating physician to use the resected flat planar surfaces to properly align the extended articulating surface on the patient. In this regard, Claim 19 has been further amended to include the limitation “aligning the pair of interior surfaces with the pair of intersecting surfaces.” Applicant submits none of the references disclose this limitation, and further, each reference suffers from the disadvantage sought to be overcome.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-3, 5-11, 13-15, 17, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over BIOMET brochure (engineering drawings submitted 7/22/1997, and cited in Applicant’s IDS of 12/17/2003) in view of Sutter et al. Claims 1-3, 6-13, 15, 17, 19-22, 24, 26, and 27 stand rejected as being unpatentable over Long

et al. (U.S. Publ. No. 2004/0193277 A1) in view of Sutter et al. Claims 5 and 14 stand rejected as being unpatentable over Long et al., as modified by Sutter et al., and further in view of Copeland™ Humeral Resurfacing Head (Biomet Orthopedics, Inc.: 2000 brochure; hereinafter the “Copeland brochure”) in view of Sutter et al. In view of the arguments and amendments herein, this rejection is respectfully traversed.

Applicant respectfully submits that none of the references cited disclose an extended articulating surface protruding from only a portion of the rim of a hemispherical articulating surface and having the extended articulating portion define a pair of intersecting flat surfaces. Further, the Office has not presented a prima facie case of obviousness. In this regard, the Office has not determined the scope and content of the prior art, ascertained the differences between the prior art and the claims, or considered the level of ordinary skill in the pertinent art. Rather, the Office has merely stated that Sutter and Long discloses resecting/resurfacing a humeral head and forming at least one planar surface and that the references both disclose forming a “v”- shaped inner surface. Applicant submits that the references do not teach the limitations as now claimed.

“Care must be taken to avoid hindsight reconstruction by using the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. *Grain Processing Corp. v. American Maize-Prods. Co.*, 5 U.S.P.Q.2d 1788, 1792 (inner quotes omitted); *see also*, *KSR*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385, 1397. The Examiner should not “pick and choose among the individual elements of assorted prior art references to recreate the

claimed invention.” *Symbol Technologies Inc. v. Opticon Inc.*, 19 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1991); *see also, In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

Applicant notes that it is wholly improper to simply combine elements of Sutter, Long, and the Biomet reference in this manner, even if all of the elements of the present claims could be found in the references. In this regard, Applicant notes that the Supreme Court has stated that “[a]s is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007). Moreover, in discussing the review of a determination of obviousness, the Supreme Court quoted from *In re Kahn* stating that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*

Applicant notes that in the wake of the KSR decision, the Board of Patent Appeals and Interferences (BPAI) appears to be enforcing the mandate for the “articulated reasoning” and “rational underpinning” to support the legal conclusion of obviousness. For example, the BPAI harshly rejected an examiner’s arguments concerning the obviousness of an invention in *Ex parte Fathman* (which they characterized as being a “willy-nilly” modification) and stated that

the inferences and creative steps derived from the prior art on this record fail to lead a person of ordinary skill in the art to Appellant’s claimed invention. On this record, the Examiner has failed to identify a viable reason why a person of ordinary skill would have been led to combine the teachings of [the cited art] in the manner set forth in Appellant’s claimed invention.

BPAI Appeal No. 2007-4156 (December 11, 2007). See also *Ex parte So and Thomas*, BPAI 2007-3967 (January 4, 2008) (BPAI cautioned against the unwitting application of hindsight and stated that “there is nothing in the applied references which would have motivated an artisan to select this particular ingredient then use the resulting composition...”).

Regarding Claim 19, Applicant respectfully submits that the Office has not presented a prima facie case of obviousness. For example, Applicant submits that the Office has provided only conclusory statements as a basis for the combination and has not provided “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In this regard, the Office has not stated why one of ordinary skill in the art, having knowledge of both Sutter, Long, or the Biomet engineering drawings, would routinely “form pair of flat planar surfaces,” prior to coupling the prosthetic to the bone, especially when these surfaces are incompatible with the interior surfaces of the cited references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 19, under 35 U.S.C. §103(a).

Claims 20-22 and 24 depend from Claim 19, and they all stand rejected under 35 U.S.C. § 103(a) by at least combining elements in the same manner. Therefore, reconsideration and withdrawal of the rejection of these claims are respectfully requested for at least the reasons stated above with reference to Claim 19.

With respect to the rejections of Claims 26 and 27, as noted during the teleconference, the base surface and upper surface can correspond to surfaces 30 and

34 (see Figure 3b). Applicant notes none of the references disclose this limitation. As such, rejection under 35 U.S.C. §103 is improper.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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